

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

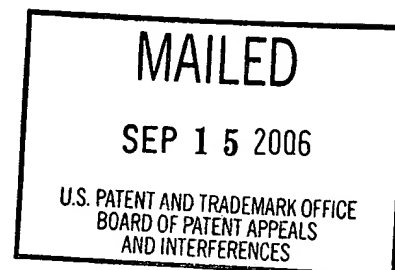
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK J. BEACH

Appeal No. 2006-0864
Application No. 09/181,402

ON BRIEF



Before HAIRSTON, JERRY SMITH, and MACDONALD, Administrative
Patent Judges.

MACDONALD, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of
claims 1-49.

Invention

Appellant's invention relates to a method, apparatus, and program product for prioritizing the transmission and display of key areas of image data. Using a preferred embodiment, a person who wants certain parts of an image to be sent before other parts of the image would select these more important areas and assign priorities to the selected parts of the image. In addition, a default priority could be assigned to areas of the image not selected or not assigned a priority. The image is then saved in a file format such that the highest priority images are placed towards the beginning of the file.

Claim 1 is representative of the claimed invention and is reproduced as follows:

1. An apparatus comprising a transmitting computer comprising:

at least one processor;

a memory coupled to the at least one processor; and

a prioritized graphics file residing in the memory, the prioritized graphics file defining higher priority image transmission portions and lower priority image transmission portions that have been selected and assigned priorities such that when the prioritized graphics file is transferred across a

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network, the higher priority image transmission portions of the prioritized graphics file are transmitted before the lower priority image transmission portions of the prioritized graphics file.

References

The references relied on by the Examiner are as follows:

Scorse	5,426,513	Jun. 20, 1995
Weber	5,477,445	Dec. 19, 1995
Cash	5,481,312	Jan. 2, 1996

Rejections At Issue

Claims 1-6, 8-12, 14-21, 23-29, 31-35, and 37-49 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Scorse and Cash.¹

Claims 7, 13, 22, 30, and 36 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Scorse, Cash, and Weber.

¹ Contrary to statements by Appellant (page 3 of the brief) and the Examiner (page 3 of the answer), the record before us contains no rejection of claim 36 based solely on Scorse and Cash.

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Throughout our opinion, we make references to the Appellant's briefs, and to the Examiner's Answer for the respective details thereof.²

OPINION

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of the Appellant and the Examiner, for the reasons stated infra, we affirm the Examiner's rejection of claims 1-6, 8-12, 14-21, 23-29, 31-35 and 37-49 under 35 U.S.C. § 103; and we reverse the Examiner's rejection of claims 7, 13, 22, 30, and 36 under 35 U.S.C. § 103.

Appellant has indicated that for purposes of this appeal the claims stand or fall together in six groupings:

Claims 1, 3, 5, 9, 11, 14-16, 18, 20, 24-26, 28, and 41-46 as Group I;

Claims 2, 8, 17, and 23 as Group II;

Claims 4, 6, 10, 12, 19, 21, 27, and 29 as Group III;

² Appellant filed an Appeal Brief on May 25, 2004, fully replacing the brief filed Sept. 22, 2003. Appellant filed a Reply Brief on Nov. 7, 2005. The Examiner mailed an Examiner's Answer on Sept. 6, 2005.

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Claims 31-35, 37-40, and 47-49 as Group IV;
Claims 7, 13, 22, and 30 as Group V; and
Claim 36 as Group VI.

See page 4 of the brief. We will, thereby, consider Appellant's claims as standing or falling together in the six groups noted above, and we will treat:

Claim 1 as a representative claim of Group I;
Claim 2 as a representative claim of Group II;
Claim 4 as a representative claim of Group III;
Claim 31 as a representative claim of Group IV; and
Claim 7 as a representative claim of Group V.

I. Whether the Rejection of Claims 1, 3, 5, 9, 11, 14-16, 18, 20, 24-26, 28, and 41-46 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the invention as set forth in claims 1, 3, 5, 9, 11, 14-16, 18, 20, 24-26, 28, and 41-46. Accordingly, we affirm.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a prima facie case of

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obviousness. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). See also In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellants. Oetiker, 977 F.2d at 1445, 24 USPQ2d at 1444. See also Piasecki, 745 F.2d at 1472, 223 USPQ at 788.

An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. "In reviewing the [E]xaminer's decision on appeal, the Board must necessarily weigh all of the evidence and argument." Oetiker, 977 F.2d at 1445, 24 USPQ2d at 1444. "[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." In re Lee, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

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With respect to independent claim 1, Appellant argues at page 7 of the brief, Claim 1 is patentable because "[the] role of the user in sequentially prioritizing and transmitting the portions of the image to be transmitted is the essence of Scorse's invention and cannot be eliminated." We disagree. Contrary to Appellant's position, placing Scorse's user created prioritized file in a memory such as in Cash before transmission in no way eliminates the essence of the Scorse invention.

Appellant further argues at page 8 that no motivation exists to save the prioritized file of Scorse because the Scorse method is extremely efficient. We disagree. "A reference may be said to teach away when a person of ordinary skill, upon reading the reference...would be led in a direction divergent from the path that was taken by the applicant." In re Haruna, 249 F.3d 1327, 58USPQ2d 1517 (Fed. Cir. 2001). We do not find this to be the situation before this Board. At most it can be argued, "the Examiner's suggestion to generate such a file and store the file in memory would actually delay transmission," (Brief at page 8).

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However, we find that being less effective is not a teaching away. "A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use." In re Gurley, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994). As the Examiner correctly points out in the rejection at page 4 of the answer, Cash discloses a memory 115 that stores the prioritized file to be transmitted until the receiver is ready to receive. Cash teaches that a request for the file is received at column 2, lines 42-43. Also, Scorse teaches that a request (column 4, lines 66-68) for resending is used in cases of incorrect transmission. Storing Scorse's file in memory as taught by Cash would be advantageous to this corrective action.

Therefore, we will sustain the Examiner's rejection under 35 U.S.C. § 103.

II. Whether the Rejection of Claims 2, 8, 17, and 23, Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in

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the art the invention as set forth in claims 2, 8, 17, and 23.
Accordingly, we affirm.

With respect to dependent claim 2, Appellant argues at pages 9-10 of the brief, that claim 2 is patentable because Cash does not teach the claimed image interpreter and related functions. Although we find merit in Appellant's point about Cash, we disagree with Appellant's conclusion because the Scorse reference teaches the feature of claim 2. See Scorse at column 3, lines 61-66, and column 6, lines 13-33.

Therefore, we will sustain the Examiner's rejection under 35 U.S.C. § 103.

III. Whether the Rejection of Claims 4, 6, 10, 12, 19, 21, 27, and 29 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the invention as set forth in claims 4, 6, 10, 12, 19, 21, 27, and 29. Accordingly, we affirm.

With respect to dependent claim 4, Appellant argues at page 11 of the brief, that claim 4 is patentable because the client of Cash stores only the high priority data. We disagree. Cash stores only the high priority data, but indicates that the low

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priority data is not stored at the client due to its large size (column 6, lines 40-43). We read this as a teaching that low priority storage at the client is known by Cash but not chosen for practical reasons.

Therefore, we will sustain the Examiner's rejection under 35 U.S.C. § 103.

IV. Whether the Rejection of Claims 31-35, 37-40, and 47-49 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the invention as set forth in claims 31-35, 37-40, and 47-49. Accordingly, we affirm.

With respect to independent claim 31, Appellant argues at page 16 of the brief, "the Examiner's basis for rejecting claim 1 is not sufficient for rejecting claim 31, because claim 1 claims an apparatus whereas claim 31 claims a method." Accordingly, Appellant contends that the Examiner has not presented any arguments directed to the selecting, assigning, and transmitting steps of claim 31. We disagree. The Examiner's rejection of

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claim 1 at page 4 of the answer discusses "selected and assigned priorities" and "transmission portions." These functions are the steps of claim 31.

Therefore, we will sustain the Examiner's rejection under 35 U.S.C. § 103.

V. Whether the Rejection of Claims 7, 13, 22, and 30 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claims 7, 13, 22, and 30. Accordingly, we reverse.

With respect to dependent claim 7, Appellant argues at page 22 of the brief, the cited references do not disclose the simulation browser adding a delay. We agree. The Examiner's general citation of the Weber abstract and column 1, line 17, through column 2, line 29, is not sufficient to meet the Examiner's initial burden of establishing a prima facie case of obviousness.

Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 103.

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VI. Whether the Rejection of Claim 36 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claim 36. Accordingly, we reverse.

With respect to independent claim 36, Appellant again presents the argument made with respect to claim 7. Again we agree.

Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 103.

Conclusion

In view of the foregoing discussion, we have sustained the rejection under 35 U.S.C. § 103 of claims 1-6, 8-12, 14-21, 23-29, 31-35 and 37-49; and we have not sustained the rejection under 35 U.S.C. § 103 of claims 7, 13, 22, 30, and 36.

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No time period for taking any subsequent action in
connection with this appeal may be extended under
37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART



KENNETH W. HAIRSTON
Administrative Patent Judge



JERRY SMITH
Administrative Patent Judge



ALLEN R. MACDONALD
Administrative Patent Judge

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SCHMEISER OLSEN & WATTS
18 E UNIVERSITY DRIVE
SUITE #101
MESA, AZ 85201